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RECORD OF ORAL HEARING
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TORU MURATA

Appeal 2007-3469
Application 09/933,017
Technology Center 2600

Oral Hearing Held: November 8, 2007

Before ANITA PELLMAN GROSS, JEAN R. HOMERE, and
JOHN A. JEFFERY, *Administrative Patent Judges*.

ON BEHALF OF THE APPELLANT:

John M. Bird, Esquire
SUGHRUE, MION, PLLC
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Washington, D.C. 20037-3213

The above-entitled matter came on for hearing on Thursday,
November 8, 2007, commencing at 2:00 p.m., at the U.S. Patent and
Trademark Office, 600 Dulany Street, 9th Floor, Alexandria, Virginia,
before Jan Jablonsky, Notary Public.

1 P R O C E E D I N G S

2 JUDGE GROSS: Whenever you're ready. You have 20 minutes.

3 MR. BIRD: Thank you. May it please the Board, I'm John Bird, on
4behalf of Sughrue Mion, and NEC Display Solutions, the assignee of this
5patent application. And I'd like to just start with the invention of claim one.

6 And referring to Figure 4, we have this ethernet communication
7means, which is between a first image and voice display means three. And
8that is controlled by remote control means 37. And there is a personal
9computer provided with a second image and voice display means 13.

10 And I'd like to refer to the bottom part of the claim, and that says,
11"Wherein said ethernet communication means as used to transfer said
12display contents, said display control, and said communication control
13between those devices."

14 Claim seven is similar to claim one, except that it's not in
15means-plus-function language and uses an ethernet communication network.

16 So referring to the rejections of record, the primary reference asserted
17by the examiner is the Miyashita reference. And referring to Figure 4 of
18Miyashita, I just wanted to mention that there is a projector that is connected
19to a computer, and the projector receives control information from the
20computer through this RS-232C serial transmission line 50. However,
21applicant contends that the computational control means sends a video signal
22to the projector via a different input, and not the same RS-232C input.

23 The examiner appears to assert that both of these signals go over the
24same input. However, we believe that the examiner is looking at the figures
25incorrectly. And the examiner then alleges that it would be obvious to

1modify the dual input of this dual input system of Miyashita with the single
2input of Yasukawa. And in this case, the examiner relies basically on this
3website, which I have not been able to access. It's not in the record.

4 JUDGE HOMERE: Wasn't the examiner relying on Yasukawa for the
5ethernet feature of the Internet connection?

6 MR. BIRD: He's relying on Yasukawa for the ethernet feature. That's
7correct, Your Honor.

8 JUDGE HOMERE: Yes, but the point of the ethernet article that
9you're referring to was a way for the examiner to explain how the RS-232
10line operates, right?

11 MR. BIRD: Yes. He was using this as a reasonable rationale for
12combining.

13 JUDGE HOMERE: Yes. And also, I think this point here, I mean, if
14you examine the examiner's answer closely, the issue of whether the RS-232
15actually teaches that the video signal goes through that, I think the examiner
16considered that. So I think that point itself is settled in the examiner's
17answer. So really, the question before us is whether the ethernet taught by
18the secondary reference can be used in lieu of the RS-232. That's the
19question.

20 MR. BIRD: And we would say that it's not obvious to use the
21ethernet in place of this 232 and the second input of the primary referenced
22Miyashita. And this website that the examiner refers to is not evidence of
23what one of ordinary skill would have been aware of at the time of the
24invention, which was filed in 2001 or 2000.

1 And therefore, it would be improper for the examiner to rely on this
2for his rationale. And without this website analysis, the examiner's
3statement is merely conclusory, where he's saying it would be just much
4better to do this.

5 Even after the Supreme Court's KSR decision, there is a basic factual
6finding of rationales that are required to support an obviousness finding.
7However, in this case, the single input of Yasukawa is only applicable to
8prerecorded image data stored on servers to a projector, and it's not
9applicable to a communication means or a communication network that's
10used to transfer display contents, display control, and also communication
11control.

12 JUDGE HOMERE: But when we go back to Yasukawa, I mean, in
13both the examiner's answer and the briefs filed, I mean, these two issues are
14settled. In the figure that's depicted as Figure 3 of Yasukawa, the ethernet
15line ultimately is to carry both video data and control data; isn't that correct?

16 MR. BIRD: I'm not going to comment on that.

17 JUDGE HOMERE: Well, that's what the brief said.

18 MR. BIRD: We believe that the combination of Yasukawa and
19Miyashita just using the ethernet --

20 JUDGE HOMERE: Excuse me. What is the extent of what
21Yasukawa teaches?

22 MR. BIRD: Yasukawa teaches this ethernet system.

23 JUDGE HOMERE: Okay. So what goes through there? Does it
24carry the video line from the servers to the projector?

25 MR. BIRD: I'm not going to comment on that.

1 JUDGE JEFFERY: Counsel, let me do this.

2 MR. BIRD: Okay.

3 JUDGE JEFFERY: Let me direct your attention to column two of the
4secondary reference. And when you bring it up, let me know. And
5specifically, lines 57 through 60 of column two. I'll just go ahead and read it
6aloud here. It basically discusses the method transferring the data that
7includes the image data and the image controlling data from the at least one
8specified server with which communication has been established to the
9projector. So I think that excerpt sort of indicates that both image data and
10control data ultimately get sent to the projector.

11 Now, the question, it seems to me, would be whether it would be
12obvious, in light of that teaching, to essentially use a unified network-based
13transmission system in lieu of RS-232C to video connectors.

14 MR. BIRD: Yes, well, our position is that the claim specifically talks
15about this remote control means that captures display contents, and that this
16ethernet communication means is used to transfer these display contents
17from the remote control and the display control and the communication
18control. And that would not have been obvious to use the Yasukawa system
19to transfer those three elements.

20 JUDGE HOMERE: Oh, you're not asking Judge Jeffery's question.
21He just read a portion to you from Yasukawa that allegedly teaches that the
22ethernet line carries both the control signal and the video signal. And I think
23the question was directed to you regarding what that particular portion
24actually teaches. I mean, I'm sure that you got prepared for this case. Did

1you have any opportunity to review the reference in its entirety for its
2teaching?

3 MR. BIRD: Well, we've reviewed the reference in its entirety, and I
4have not seen anything that would show a specific use in the claimed
5manner.

6 JUDGE JEFFERY: Let me make sure I understand. We basically
7have two types of control data that's being claimed, right? We've got the
8display control, and we have the communication control. Those are two
9distinct control aspects, if you will. Signals.

10 MR. BIRD: Yes.

11 JUDGE JEFFERY: And then the contents is the third element. So
12you're saying -- I mean, I think your position is, notwithstanding the
13teaching of the secondary reference of transferring both control data and
14image data to the projector through this ethernet-based thing, it wouldn't be
15obvious to transmit two types of control signals -- that is to say, the display
16control and the communication control -- in addition to the display contents
17themselves. Is that it?

18 MR. BIRD: Yes, that is the applicant's position. Yes. Yes, sir, that
19is. And we wanted to reiterate that this brief was filed before the KSR
20decision came out. And now there are more rationales that the examiners
21will typically rely on, but in this case we still don't see the proper rationale.

22 And with respect to, specifically, the teaching motivation or
23suggestion test, we feel that the examiner's analysis is missing. And this
24combination, in which the communication means is transferred to three
25items -- the display contents, display control, and the communication

1control -- we'd say it's more than a predictable use of the prior elements,
2which you'd find in KSR.

3 JUDGE JEFFERY: Well, counsel, let me ask you this. Going back to
4the base reference, Figure 4, which is the key figure, as you indicated, shows
5the RS-232 line 50 between the projector and the computer. I mean, if I
6were to decide as an engineer that I wanted to network this particular
7arrangement -- that is to say, I wanted multiple projectors and multiple
8computers -- and I wanted to tie all this together via a network, wouldn't I
9think to provide some sort of high bandwidth connectivities -- i.e., an
10ethernet capability -- to connect these things up as communication?

11 MR. BIRD: Well, our position is that you would not have been
12motivated to do that, and it would not have been obvious.

13 JUDGE JEFFERY: Okay.

14 JUDGE HOMERE: Are you familiar with the ethernet technology?
15Do you know what an ethernet line does?

16 MR. BIRD: I'm familiar with the ethernet technology.

17 JUDGE HOMERE: Okay.

18 MR. BIRD: I'm not an expert in that technology area.

19 JUDGE HOMERE: I understand. Are you aware that the ethernet
20itself, the ethernet line, is capable of carrying control data and video data?

21 MR. BIRD: I'm aware of that, yes. But for there to be a reason or
22rationale to use it to carry our specific two types of control data, we don't see
23any reason to do that.

1 JUDGE HOMERE: No, but you just said that you are aware that the
2 ethernet line itself is capable of carrying both control data and video data; is
3 that correct? That's what you just said, right?

4 MR. BIRD: Yes, I believe so, but -- I'll say I believe so.

5 JUDGE HOMERE: Okay. So, I mean, what is so special about this
6 type of control data that the ethernet line would not be able to carry this
7 specific type of control data you're referring to? Because, I mean, you
8 admitted on the record here that while the ethernet line itself is capable of
9 carrying both control data and video data, now on the other hand you're
10 saying that, well, this specific type of control data as claimed here, well, you
11 don't see any motivation, you don't see why anyone else would be motivated
12 to carry that specific type of control data in the ethernet line. So what is so
13 special about that particular control data, that ethernet line that, as you
14 admitted, the artisan would know that it's capable of carrying control data
15 and video data, would not be able to carry that?

16 MR. BIRD: Well, this is display control data that comes from the
17 remote control through the -- that was used to control the projector itself. So
18 just to use that control data on the second feature, the computer, we don't see
19 that occurring.

20 JUDGE HOMERE: But why would the ethernet line not be able to
21 carry that control data, when you say that it's capable of carrying control
22 data generally, and video data? What's so special about this control data?

23 MR. BIRD: Well, we would say that one of ordinary skill would not
24 have looked to that to do that, would not have looked to the ethernet
25 technology to do that.

1 JUDGE HOMERE: Why not?

2 MR. BIRD: Why not? Because -- I'm not ready for that answer.

3Thank you.

4 JUDGE GROSS: Do you have anything else?

5 MR. BIRD: No. Thank you for your time. I appreciate it. Thank
6you, Your Honors.

7 JUDGE GROSS: All right.

8 (Whereupon, at 2:13 p.m., the proceedings were concluded.)

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